



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/556,949	04/21/2000	Yasuo Nomura	203722US6	6510

22850 7590 06/11/2009
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

ZHAO, DAQUAN

ART UNIT	PAPER NUMBER
----------	--------------

2621

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

06/11/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 09/556,949	Applicant(s) NOMURA ET AL.	
	Examiner DAQUAN ZHAO	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 8-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/22/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's arguments, see Pre-Brief Conference request, filed 8/8/2008, with respect to the rejection(s) of claim(s) 1-7 and 25 under 35 U.S.C 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Nakagaki et al (US 5,852,474).

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 6- 7 are rejected under 35 U.S.C. 101 because claim is directed to non-statutory subject matter.

Claim 7 recites "a medium", wherein page 13 of the specification of the instant application recites "Figs. 45A, 45B and 45C are explanatory views of storage media", and figure 45C shows "network" 531. Therefore, The examiner believes the claimed "medium" can be interpreted as "network", which can just be signal per se.

Claim 6 is rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or

Art Unit: 2621

(2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory. The claimed method invention can broadly interpreted as an abstract idea written on a piece of paper as a flow chart as shown in figure 30 of the specification of the instant application.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2621

3. Claims 1-7&25 rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki et al (US 5,111,299) in view of Small et al (US 5,898,434) and further in view of Nakagaki et al (US 5,852,474).

Regarding claim 1, Aoki et al disclose a still camera that is provided with at least one module changing device, a time/date device or an exposure compensating device which can be used with the still video camera that is provided with a playback device or an audio recording/playback device, comprising:

a) recording unit configured to record a first supplied picture (see Fig.2, record/playback circuit 35; col.6, line 63 to col.7, line 8; and col.8, lines 13-22);

b) reproducing unit configured to reproduce a second recorded picture (see Fig.2; record/playback circuit 35, and voice reproduction circuit 54; col.8, lines 13-38);

c) display controlling unit configured to provide display control in such a manner as to display a first user interface when the recording unit records the first picture supplied and to display a second user interface wherein the reproducing unit reproduces the second picture recorded (see col.10, line 50 to col.11, line 38), here "REC" is displayed during recording and "PLAY" is displayed during playback;

Aoki et al fail to explicitly disclose wherein the first user interface displays recording button through which to input orders for operating the recording unit and a playback button through which to input orders for operating the reproducing unit and second user interface displays a recording button through which to input orders for operating the recording unit, and a playback button through which to input orders for operating the reproducing unit.

Small et al teach software techniques for marking, decorating, and organizing data within a computer system, including a user interface system having a collection of different user interface elements, each having a unique identity and programmed functional characteristic that allows each element to be used to mark, find, organize, and process data in documents within a computer system comprising the dialog box 180 of Fig.11. For example, if the user associated the picture 182 to an instance of sound element 178, at least a portion of picture 182 would appear within sound dialog box 180 (claimed first interface). The user then use the record button 184 to activate a recorder to record a sound for storage in memory 8 until the record time is passed. The user could then playback the recorded sound by selecting play button 186. Of course, dialog box 180 (claimed second interface) could be reactivated at anytime by selecting the instance of the sound element 178 in a different manner and repeat the recording and playback of another sound (see col.15, line 49 to col.16, line 3).

Selecting different interfaces for selected different dialog boxes provides the desirable advantage of facilitating the playing/recording, for example, of the different sounds, thereby facilitating the multi-recording/playing of different sounds, using different interface modes.

It would have been obvious to modify Aoki by realizing Aoki with the means to select different interfaces for selected different sounds since this provides the desirable advantage of facilitating the playing/recording, for example, of the different sounds, thereby facilitating the multi-recording/playing of different sound, using different interface modes.

Aoki et al and Small et al fail to teach a button accepts a user input while the other button does not accept user input. Nakagaki et al teach a button accepts a user input while the other button does not accept user input (e.g. column 7, lines 3-27 “with the record button 47 kept in the non-active state, when the playback button 50 is depressed...”). It would have been obvious to one ordinary skill in the art at the time the invention was made to incorporate the teaching of Nakagaki et al into the teaching of Aoki et al and Small et al for immediately reviewing any scenes missed during a television program and efficiently satisfying the user’s requirements (e.g. Nakagaki et al, column 17, lines 12-19).

Regarding claim 2, Aoki discloses wherein the recording means records simultaneously at least one picture making up the first picture (see col.10, line 61 to col.11, line 2), here the word “REC” is displayed to indicate that the recordingg process is going on at the instant

Regarding claim 3, Aoki discloses wherein the reproducing means reproduces simultaneously at least one picture making up the second picture (see col.10, line 61 to col.11, line 38), here the word “PLAY” is displayed to indicate that the reproducing process is going on at the instant

Regarding claim 4, Aoki discloses wherein the display controlling means provides display control in such a manner that the first and the second user interface appear in substantially the same position (see col.10, lines 50 to col.11, line 2), here Aoki discloses that the camera has a record mode during which “REC” icon is displayed and a monitor mode during which “MONITOR” icon is displayed, and in the monitor mode the image being recorded can be simultaneously monitored.

Regarding claim 5, Aoki discloses wherein the display controlling means displays the first user interface in such a manner as to place a first and second display thereof into a first and a second state respectively, the first display in the first state accepting an input of orders via a recording button for operating the recording means, the second display in the second state accepting an input of orders via a playback button for operating the reproducing means, the display controlling means further displaying the second user interface in such a manner as to place the first and second display thereof into the second and the first state respectively, the first display in the second state accepting an input of orders via a recording button for operating the recording means, the second display in the first state accepting an input of orders via a playback button for operating the reproducing means (see claims 2&3 discussions above), here examiner reads the first state as the recording state and the second state as the reproducing state.

Regarding claim 6, the claimed limitations of claim 6 are accommodated in the discussions of claim 1 above.

Art Unit: 2621

Regarding claim 7, the claimed limitations of claim 7 are accommodated in the discussions of claim 1 above.

Regarding claim 25, the claimed limitations of claim 25 are accommodated in the discussions of claim 1 above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daquan Zhao whose telephone number is (571) 270-1119. The examiner can normally be reached on M-Fri. 7:30 -5, alt Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Thai Q, can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daquan Zhao/
Examiner, Art Unit 2621

/JAMIE JO VENT ATALA/
Examiner, Art Unit 2621